

**REMARKS**

Applicants submit that the amendments herein are fully supported in the present specification as filed and add no new matter. Also, it is respectfully requested that the present Amendment be entered into the Official File in view of the fact that the Amendment automatically places the application in condition for allowance.

In the alternative, if the Examiner continues with the rejections of the present application, it is respectfully requested that the present Amendment be entered for purposes of an Appeal. The Reply reduces the issues on appeal by reducing the number of claims (e.g., claim 6) and rendering some rejections moot. Thus, the issues on appeal would be reduced.

A Petition for Extension of Time and a Notice of Appeal are being concurrently filed with this Amendment. Thus, this Amendment is being timely filed.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

***Status of the Claims***

In the present Amendment, claim 7 has been amended. Also, claim 6 has been canceled without prejudice or disclaimer of the subject matter contained therein. Thus, claims 2, 3, 4 and 7 are currently pending in the present application.

No new matter has been added by way of these amendments. The amendment to claim 7 has support in the present specification at page 11, lines 12-16. The dependencies of claims 2-4 were appropriately changed with the cancellation of claim 6.

Based upon the above considerations, entry of the present Amendment is respectfully requested.

***Issues Under 35 U.S.C. § 112, First Paragraph***

Claims 6 and 2-4 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Office Action, paragraphs 7-8). It is believed that this rejection has been rendered moot since claim 6 has been canceled. Also, claims 2-4 now depend on claim 7. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

***Issues Under 35 U.S.C. § 112, Second Paragraph***

Claims 6, 7 and 2-4 stand rejected under 35 U.S.C. § 112, second paragraph, as stated in paragraphs 9-12 of the Office Action. It is believed that the rejection of claim 6 has been rendered moot since this claim has been canceled.

Regarding the term “small,” this term no longer appears in claim 7. Also, claims 2-4 now depend on claim 7.

Based on the above, reconsideration and withdrawal of this rejection are respectfully requested.

***Issues Under 35 U.S.C. § 103(a)***

Claims 2-4, 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 0791688 (hereinafter “**Yamazaki**”) in view of “**Smook**” (*Handbook for Pulp & Paper*

*Technologies*, section 20.7) (see paragraphs 13-17 of the outstanding Office Action). Applicants respectfully traverse.

As described in the present specification at page 10, lines 8-14, the present invention utilizes a double-side dehydration type wire part. In turn, there is a certain amount of calcium carbonate in a surface layer on each side of a top side and a bottom side of the wrapper paper, and that amount in the surface layer is less than the amount of calcium carbonate contained within the wrapper paper. Applicants note that the surface layer is (now) defined as the region in a thickness direction from a surface of the wrapper paper (see pending claim 7 herein). Also, the surface layer corresponds to 18 to 20% by mass of an entire mass of the wrapper paper.

The cited primary reference of Yamazaki fails to disclose or suggest lowering the amount of calcium carbonate in the surface layer that is smaller than the amount of calcium carbonate within the wrapper paper. Further, Yamazaki does not disclose or suggest using a double-side dehydration type wire part to make its wrapping paper such that the specified amount of calcium carbonate is obtained.

The cited secondary reference of Smook does not account for the deficiencies and problems of Yamazaki. Smook merely relates to tissue papers. The Smook reference fails to disclose or suggest making cigarette papers by a twin wire former. Thus, Applicants respectfully submit that Smook is improperly combined with Yamazaki and that the cited combination does not disclose all claimed features.

Regarding whether or not claim language appearing in the preamble should be given patentable weight (see, e.g., the Office Action at page 2), M.P.E.P. § 2111.02 also states such a determination is made on a case-by-case basis and that “there is no litmus test defining when a

preamble limits the scope of a claim.” *Catalina Mktg. Int’l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002). And as stated in M.P.E.P. § 2111.02(I), any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. *See, e.g., Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). Here, Applicants note there is a difference between simply reciting a “wrapper paper” versus a “twin wire type wrapper paper”. Also, Applicants note the specification starting at page 10, line 23. Reconsideration of “twin wire type wrapper paper” is respectfully requested.

Based on the above and the evidence and arguments of record, reconsideration and withdrawal of this rejection are respectfully requested.

### ***Conclusion***

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

**Application No. 10/706,038**

**Docket No.: 0042-0491P**

**Art Unit 1791**

**After Final Office Action of March 30, 2009**

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: September 30, 2009

Respectfully submitted,

By 

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